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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/825,848	04/16/2004	Kenneth J. Onion	KSW 329	8187

500 7590 06/15/2006

SEED INTELLECTUAL PROPERTY LAW GROUP PLLC
701 FIFTH AVE
SUITE 6300
SEATTLE, WA 98104-7092

EXAMINER

LANDRUM, EDWARD F

ART UNIT	PAPER NUMBER
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3724

DATE MAILED: 06/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/825,848	Applicant(s) ONION, KENNETH J.	
	Examiner Edward F. Landrum	Art Unit 3724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) 36-44 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 April 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/14/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Claims 36-44 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 5/1/2006.

Applicant's election without traverse of claims 1-35 in the reply filed on 5/1/2006 is acknowledged.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the post engaging the end surface only after reaching the latching corner must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an

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application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 17-35 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. It is not understood how the post of claim 17 is spaced away from the edge surface of the handle until the post engages the latching corner of the edge surface when the disclosure (specifically pg. 6, lines 12-17) teaches the post engages the edge surface of the handle before reaching the latching corner.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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6. Claims 1, 3-7, 17, 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Onion (U.S Patent No. 6,378,214).

Onion teaches (see Figures 3, 10, and 11) a folding knife comprising: a handle (16) having an end face (16b) with a notched corner in the end face of the handle forming a first locking element (16d); a blade (12) pivotally mounted to the handle with a slot (60); a second locking element located in the slot (60) that includes a neck (30) and two coaxially mounted roller bearings (130) designed to retain the neck (30) in the slot (60) and to prevent scratching or wearing of the edge surface of the handle (16b) as well as improve the smoothness of the locking mechanism. Figure 3 shows the second locking element (30) being faced from the end face (16b) of the handle (16) for a substantial portion of the movement of the blade from the closed to the open position. A spring (62) and an attachment member (64) are provided in the slot (60) to bias the second locking element (30, 130) to a first position.

Regarding claim 17, the second locking element/post (30, 130) can be held in the 2nd position by the user for the duration of pivoting the blade from a closed to an opened position and therefore the second locking element/post (30, 130) would not touch the edge surface until the user releases the second locking element (30, 130) to engage it with the latching corner (16d).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Onion.

Onion teaches all of the elements of the current invention as stated above except when the blade is pivoted from the closed to the open position the second locking element contacts the end face of the handle after the blade travels at least 75% of the total travel between the closed and open position.

At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to make the second locking element touch the end face of the handle only after traveling at least 75% of the distance between closed and open positions because Applicant has not disclosed that preventing the second locking element from touching the end face of the handle for the aforementioned 75% distance provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Onion's design, and applicant's invention, to perform equally well with either the minimum contact distance as taught by Onion or the claimed minimum contact distance because both minimum contact requirements between the second locking element and the end face of the handle would perform the same function of guiding the second locking element to the latch corner equally well.

Therefore, it would have been prima facie obvious to modify Onion to obtain the invention as specified in claim 2 because such a modification would have been considered a mere design consideration which fails to patentably distinguish over the prior art of Onion.

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9. Claims 8-16, and 19-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Onion.

Onion teaches all of the elements of the current invention as stated above except: the slot comprising first and second portions, the first portion being larger than the second; a retaining element positioned in the first portion of the slot and extending into the second portion of the slot; and the retaining element comprising a hole designed to receive a ball bearing that expands the retaining element.

It would have been obvious to provide an enlarged end in the slot and an expandable retaining element for preventing the neck from leaving the slot in Onion since the examiner takes Official Notice of the equivalence of the two different types of slots and prevention means in the connection art and the selection of either of these known slot and prevention structures to form the slot and retention means of Onion would be within the level of ordinary skill in the art.

Examiner takes Official Notice the fact that providing a slot with an enlarged end and a retaining element to fit into the enlarged end is known in the connection art to be equivalent to a slot without an enlarged end where the retaining element is attached to the neck after the neck has been inserted in the slot for use in the prevention of the neck falling out of the slot. To substitute a slot with an enlarged end and a retaining element in Onion for the disclosed slot and retention element would have been an obvious functional equivalent.

Furthermore, at the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to provide a slot with an

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enlarged distal end and a retaining element to close the enlarged end because Applicant has not disclosed that enlarging the end of the slot and using an expandable retaining element provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Onion's slot and retention design, and applicant's invention, to perform equally well with either the slot and retention means taught by Onion or the claimed slot and retention device because both would perform the same function of preventing the neck from falling out of the slot equally well.

Therefore, it would have been prima facie obvious to modify Onion to obtain the invention as specified in the claims because such a modification would have been considered a mere design consideration which fails to patentably distinguish over the prior art of Onion.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Onion '431 (U.S Patent No. 6,338,431), Sakai (U.S Patent No. 6,154,965), Poehlmann (U.S Patent No. 4,893,409), Eikhorn (U.S Patent No. 6,523,265), Lake et al (U.S Patent No. 6,490,797), Moser (U.S Patent No. 6,308,420), Walker (U.S Patent No. 4,979,301), and Neely (U.S Patent No. 5,060,379) teach foldable knives with first and second locking elements.

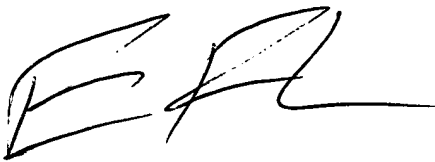
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11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward F. Landrum whose telephone number is 571-272-5567. The examiner can normally be reached on Monday-Friday 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer Ashley can be reached on 571-272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

EFL
6/11/2006



BOYER D. ASHLEY
SUPERVISORY PATENT EXAMINER